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Docket No. 24012-108

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Albert D. Edgar

Serial No.: 09/487,967

Group Art Unit: 2851

Filed: January 18, 2000

Examiner: Rutledge, D.

For: **METHOD AND APPARATUS FOR REDUCING NOISE IN
ELECTRONIC FILM DEVELOPMENT**

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APPLIED SCIENCE FICTION

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-09/778028
**PETITION TO REQUIRE EXAMINER TO CONSIDER
REFERENCES SUBMITTED IN INFORMATION DISCLOSURE STATEMENT**

Box Non-Fee Amendment
Assistant Commissioner of Patents
Washington, DC 20231

Dear Sir:

Pursuant to 37 C.F.R. 1.181, Applicant petitions the Commissioner to require the Examiner in the above-identified patent application to consider all references properly and timely submitted in an Information Disclosure Statement on July 25, 2000.

I. FACTUAL BACKGROUND

On July 25, 2000, Applicant filed a Request for Continued Examination in the above-identified application. Accompanying the Request was an Information Disclosure Statement ("IDS") filed in accordance 37 C.F.R. 1.56 and 37 C.F.R. 1.97 and 1.98. The IDS included 134 United States and foreign patent references and 11 non-patent references. All of the references were identified and included on a Form PTO/SB/08A (formerly PTO-1449), and legible copies of all of the references also were included.

The Examiner has received the IDS and the references cited therein, but has indicated that the references will not be considered. The Examiner does not contend that the IDS submission was untimely or that it otherwise fails in any way to comply with the requirements of 37 C.F.R. 1.97 or 1.98. Instead, the only stated reason for the Examiner's refusal to consider the cited references is that the number of references submitted is too large. Accordingly to the Examiner, "[b]y submitting such a large volume of prior art, it is apparent that the applicant has not tried to eliminate any irrelevant and cumulative information." As best understood by Applicant, the Examiner's refusal to consider the references is based upon the amount of time that such review would entail. The Examiner has suggested that a new IDS should be filed with fewer references.

Applicant has requested reconsideration of this refusal to consider the submitted references in a telephone conference with the Examiner. During that telephone conference, it was agreed between Applicant's attorney and the Examiner that further written requests for reconsideration would not advance the present dispute, and that the matter could best be advanced by the filing of a petition.

As explained to the Examiner in a telephone conference, it is believed that each of the references cited in the IDS have been considered by an examiner, either in the United States or foreign countries, in closely related patent applications of the assignee relating to digital film processing. Such consideration by examiners during the prosecution of closely related applications suggests that the examiners responsible for these related applications believed the cited references to be material. Under such circumstances, Applicant is reluctant to exclude any of the submitted references in a new, resubmitted IDS containing fewer references, as has been suggested by the Examiner. This is particularly so since it is arguable that Applicant has an obligation to disclose each of these references under 37 C.F.R. 1.56. (See, e.g., MPEP 2001.06 (a) and 2001.06(b)).

II. QUESTIONS SUBMITTED BY PETITION

This issues raised by this petition is whether the Examiner has the discretion to refuse to consider references that are properly and timely submitted in an IDS that fully complies with 37 C.F.R. 1.97 and 1.98. In addition, if Commissioner finds that the Examiner does have such discretion, a further issue would be raised as to whether the Examiner abused such discretion in this particular application.

III. REASONS WHY THE EXAMINER IS OBLIGATED TO CONSIDER THE REFERENCES

A. The Examiner Was Obligated To Consider The References Under The Rules And PTO Policy

The rules governing the filing of an IDS do not give the Examiner discretion to decide whether to review references in a properly and timely filed IDS. Section 609 of the Manual of Patent Examining Procedure (MPEP) provides, in pertinent part, that [a]n information disclosure statement filed in accordance with 37 CFR 1.97 and 37 CFR 1.98 provides the procedure available to an applicant to submit information to the Office so that the information will be considered by the examiner assigned to the application." (emphasis added.) That section of the MPEP further provides that once the minimum requirements of 37 C.F.R. 1.97 and 1.98 are met "the examiner has an obligation to consider the information." (emphasis added). As is apparent from this provision of the MPEP, the Examiner is obligated to consider information properly and timely submitted under 37 C.F.R. 1.97 and 1.98. No discretion on the part of the Examiner is provided. To the contrary, the very purpose of the rules is to "provide certainty for the public by defining the requirements for submitting information to the Office so that the Office will consider information before a patent is granted." MPEP 609. Neither the MPEP nor the applicable rules contain any limitation on the number of references submitted. Furthermore, neither the MPEP nor the rules provide

any discretion on the part of the Examiner as to whether information that is properly and timely submitted should be considered.

B. Even If Discretion Existed, The Refusal In This Case Would Be Inappropriate

Even if the rules provided discretion to the Examiner in this situation (and it is submitted that they do not), it is submitted that any decision not to consider the references submitted in this application would be an abuse of that discretion. The Examiner has assumed, apparently without reviewing the references, that Applicant's IDS includes references that are not material, or that are merely cumulative. The Examiner's assumption in this regard is factually misplaced. As reflected in the attached affidavit of Stacy Cook, Applicant has reviewed the materials cited in its other applications and submitted in the IDS only those references related to the technology to which the claims of the application are directed. Other cited references that clearly do not relate to the subject matter of the claimed invention have not been submitted.

According to the position taken by the Examiner, Applicant's IDS submission does not comply with 37 C.F.R. 1.56 because "the submission does not comply with the intent of 37 C.F.R. 1.56" and that the submission "goes against the policy for which the Rule was written." Applicant respectfully disagrees with the Examiner's interpretation of the policy of 37 C.F.R. 1.56, and notes that the Examiner's interpretation is inconsistent with the MPEP. As noted above, it is believed that all of the references included in the IDS have been cited by examiners in the prosecution of closely related applications involving the same technology. (See attached affidavit of Tami Johnson). Under these circumstances, there may be a strong inference of materiality, and submission of such references arguably is mandatory. MPEP 2001.06(a) and 2001.06(b).

The Examiner appears to suggest that the submission of any references whose disclosure is not mandatory under 37 C.F.R. 1.56 is prohibited. However, 37 C.F.R. 1.56 sets

the minimum standards for disclosure that is required. It does not prohibit submission of references whose disclosure may not be mandatory. Contrary to the Examiner's position, it is not improper to submit references that arguably may not be "material" within the meaning of 37 C.F.R. 1.56. The MPEP specifically provides that information may be submitted in an IDS even though disclosure of the information might not be mandated by 37 C.F.R. 1.56. Specifically, the MPEP provides that an applicant:

"may want the Office to consider information for a variety of other reasons; e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related application filed in another country, or to make sure that the examiner has the opportunity to consider the same information that was considered by the individuals that were substantively involved with the preparation or prosecution of a patent application."

MPEP 609.

It is assumed that the Examiner has refused to consider the submitted references out of concern that review of such references would be time consuming. If so, that basis of refusal is invalid for a number of reasons. First, there is no basis in the rules or policy (as set forth in the MPEP) to refuse to properly examine an application merely because it might be time consuming. Secondly, the review of a collection of references that have been considered by other examiners in related applications can be useful to focus a search to the most relevant references. From the viewpoint of examining, the submitted references might be considered to be the functional equivalent of a "Digest." Certainly the Examiner would not, and should not, refuse to examine references in a highly relevant "Digest" merely because such examination might take more time than desired. While it is unlikely that the Examiner would cite every reference in a "Digest," or that every reference would be "material" within the meaning of 37 C.F.R. 1.56, it would be irresponsible for the Examiner not to review those references. Similarly, there can be no basis for refusing to review an IDS submission (which

could be viewed as being functionally equivalent to a "Digest") merely because the references were organized by the Applicant (through the citation by examiners in related cases) rather than by an examiner in the USPTO. This is true regardless as to whether every reference in the IDS is "material" within the meaning of 37 C.F.R. 1.56. In either instance, the refusal to review the references is contrary to the PTO goals of providing quality examination.

Furthermore, it is submitted that the time involved in reviewing the submitted references would be substantially less than suggested by the Examiner. It is presumed that the Examiner already has performed a thorough search of the prior art in examining the application. Due to the likely pertinence of the submitted references (an inference that is reasonably assumable from the fact that each has been cited in related applications), it reasonably can be assumed that the Examiner already has located and reviewed the majority of the submitted in the IDS during the course of the examination that already has been completed. If that assumption is true, then the additional time required to consider the IDS would be minimal, as it is likely that most, if not all, of the references already have been consider (but not necessarily cited) during the examination that has occurred to date. If, on the other hand, the assumption is not true, it would imply that the Examiner's search has not been as thorough or complete as is desirable, and there are obvious and significant reasons why the references submitted with the IDS should be considered by the Examiner prior to issuance of the patent.

Finally, it should be noted that Applicant faces significant practical risks by reducing the number of references submitted with the IDS, as has been suggested by the Examiner. Since all of the references have been considered by examiners in related applications, there is a practical risk that the elimination of any of the originally submitted references in a resubmission could result in charges that Applicant did not comply with the duty of disclosure. As a practical matter, that risk exists regardless of what references might be

selected, and what references might be eliminated in resubmitting an IDS with less than all of the originally submitted references.

In summary, it is submitted that the Examiner is obligated to consider each of the properly and timely references in the IDS, and that there is no authority under the rules or statute that gives the Examiner the discretion to refuse to consider the references. It is further submitted that the Examiner's refusal to consider the references is not only contrary to the rules and the MPEP, it is contrary to the goal of the PTO to provide quality examination of patent applications.

IV. REQUESTED RELIEF

It is requested that the Commissioner issue an order requiring the Examiner to review each of the references cited in the IDS.

Respectfully submitted,

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